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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 10/717,940 | 11/20/2003 | David N. Nappier | BING-1-1045 | 9008 |
| 46020 | 7590 | 02/09/2006 | EXAMINER | |
| BLACK LOWE & GRAHAM PLLC 701 FIFTH AVENUE, SUITE 4800 SEATTLE, WA 98104 | | | HOWELL, DANIEL W | |
| | | | ART UNIT | PAPER NUMBER |

3722

DATE MAILED: 02/09/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|-------------------------------|-------------------------------|--|
| Office Action Summary | Application No. 10/717,940 | Applicant(s) NAPIER ET AL. | |
| | Examiner Daniel W. Howell | Art Unit 3722 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-39 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-6, 8-11, 14-18, 20 and 22-35 is/are rejected.
- 7) ☒ Claim(s) 7, 12, 13, 19, 21 and 36-39 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>3-10-04</u> . | 6) <input type="checkbox"/> Other: ____. |

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1. The use of the trademark PAR-A-MATIC™ has been noted in this application. It should be capitalized wherever it appears and be accompanied by the generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-6, 8-11, 14-18, 20, and 22-35 are rejected under 35 U.S.C. 102(b) as being anticipated by Schultz (4,198,180). Figure 2 shows a housing 30, 23, having an input 31, an output 38, and threads 23A to attach to a drill spindle 18. Air tube 24 supplies air to the input. Body 35 has a threaded portion for holding a chuck 19, and appropriate keyways for pins 36, in order to permit the body and housing to slide axially relative to each other while rotating together. Spring 37 biases the body 35 axially forward in order to seat valve 33 on valve seat 32. The position in which the body is biased to its axially forward-most position may be considered to be a first position (and the zero thrust condition of claim 24), and the position in which the valve is separated from the seat may be considered to be a second position. Figure 4 shows that the supply member may be constituted as a collar which surrounds the valve assembly while permitting rotation of the valve assembly. Regarding claim 8, fitting 67 constitutes a projection, and it is connected to source 68. With respect to claim 22, the Schultz apparatus will clearly sense a first thrust value, and when the tool enters a harder material (note that Schultz is drilling

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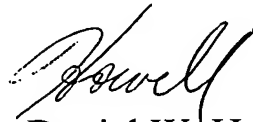
a laminate material) a second thrust condition will be sensed (this would be the non-zero thrust condition of claim 25). At some point after this second condition is sensed, springs 37 will bias the valve 33 back into contact with the seat, such that the step of sensing a return to the first condition will happen. Regarding the “retracting” step of claims 22 and 29, it is noted that the valve system 23 of Schultz controls the rate of rotation of the motor as the drill bit enters different layers of the laminate (see column 4, line 33, to column 5, line 13). However, it is inherent that the tool be retracted from the workpiece such that the next hole may be drilled (regarding claims 28 and 35, it is noted that it is conventional for the tool to continue rotating during retraction, as air is still being supplied to the motor). It is noted that claims 22 and 29 do not set forth any connection between the operation of the valve and the act of retracting the drill from the workpiece (no such connection is set forth until claim 36, which has not been rejected under art). Regarding claims 26 and 33, it is noted that the valve assembly both rotates and moves axially forward during operation.

4. Claims 7, 12-13, 19, 21, and 36-39 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

5. Any inquiry concerning the content of this communication from the examiner should be directed to Daniel Howell, whose telephone number is 571-272-4478. The examiner's office hours are typically about 10 am until 6:30 pm, Monday through Friday. The examiner's supervisor, Boyer Ashley, may be reached at 571-272-4502.

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In order to reduce pendency and avoid potential delays, Group 3720 is encouraging FAXing of responses to Office actions directly into the Group at FAX number to 571-273-8300. This practice may be used for filing papers not requiring a fee. It may also be used for filing papers which require a fee by applicants who authorize charges to a USPTO deposit account. Please identify Examiner Daniel Howell of Art Unit 3722 at the top of your cover sheet.

A handwritten signature in cursive script, appearing to read "Howell", written in black ink.

Daniel W. Howell
Primary Examiner
Art Unit 3722